

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pinkerton Service Corporation
v.
Senior Technologies, Inc.

Opposition No. 108,377
to application Serial No. 75/129,205
filed on July 2, 1996

Gordon E. Gray III and Albin H. Gess of Price and Gess
for Pinkerton Service Corporation.

Vincent L. Carney for Senior Technologies, Inc.

Before Quinn, Hairston and Rogers, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Senior Technologies, Inc. has filed an application
to register the mark depicted below,



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for "alarms for health care facilities, namely, door alarms to prohibit unauthorized exit or unauthorized entry."¹

Pinkerton Service Corporation has opposed registration. As grounds for the opposition, opposer alleges that it and its predecessors in interest have used the mark WE NEVER SLEEP along with a realistic depiction of a human eye since before 1884 in connection with the rendering of security and investigation services to customers of every type; that a stylized eye design has been in use at least since 1976 in connection with security and investigation services and the protection of people and property; and that it is the owner of the following valid and subsisting trademark registrations:

- (a) WE NEVER SLEEP and the depiction of a human eye shown below,

¹ Serial No. 75/129,205 filed July 2, 1996, alleging dates of first use of January 23, 1989.



for "private detective investigations and
property surveillance;"²

² Registration No. 539,452 issued March 13, 1951; renewed.

- (b) PINKERTON and the stylized eye design depicted below,



for "making private investigations and security surveys for others; maintaining surveillance, control and protecting people and physical property;
providing uniformed security forces;"³

- (c) PINKERTON and the stylized eye design depicted below,



for "providing guard services, security patrol services, and investigation services; namely, service quality investigations, background investigations, financial conditions investigations,
fact verification investigations, personal protection, surveillance undercover investigation;"⁴

³ Registration No. 1,078,654 issued November 29, 1977; renewed.

⁴ Registration No. 1,778,207 issued June 22, 1993; affidavits under Sections 8 and 15 accepted and acknowledged, respectively.

- (d) PINKERTON and the stylized eye design depicted below,



for "risk assessment service; namely, providing reports and information regarding potential threat and vulnerability to harm to persons travelling abroad;"⁵ and

- (e) PINKERTON and the stylized eye design depicted below,



for "servicing of automatic financial teller machines (ATMS) and point of sale machines for financial institutions; namely, restocking of cash

⁵ Registration No. 1,780,710 issued July 6, 1993; affidavits under Sections 8 and 15 accepted and acknowledged, respectively.

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and supplies;" and "repair of automatic financial services machines; namely, automatic teller machines (ATMS) and point of sale machines for financial institutions."⁶

Opposer alleges that applicant's mark, when used in connection with its identified goods, so resembles opposer's previously used and registered marks set forth above, as to be likely to cause confusion.⁷

In addition, although not pleaded in the notice of opposition, opposer made of record by means of notice of reliance a status and title copy of Registration No. 1,077,153 issued November 8, 1977 (renewed) for the stylized eye design shown below,



for "making private investigations and security surveys for others; maintaining surveillance, control and

⁶ Registration No. 1,790,672 issued August 31, 1993; affidavits under Sections 8 and 15 accepted and acknowledged, respectively.

⁷ Opposer also pleaded ownership of Registration No. 1,788,407 for the mark PINKERTON and a stylized eye design for "employment agency services." Office records show that this registration

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protecting people and physical property; providing
uniformed security forces." The status and title copy of
Registration No. 1,077,153 was submitted with the notice
of reliance which

was canceled December 23, 2000 under Section 8 of the Trademark
Act. Thus, we will give no consideration to this registration.

included, inter alia, status and title copies of opposer's pleaded registrations. The registration was specifically identified in the "Exhibit List" accompanying the notice of reliance. In view thereof, and inasmuch as applicant has not objected to the registration, we deem the notice of opposition amended pursuant to Fed. R. Civ. P. 15(b) to plead ownership of this registration and a likelihood of confusion therewith.

Applicant, in its answer, denied the salient allegations of the opposition.

The Briefs and Arguments

Before turning to the record and the merits of this case, we must discuss several preliminary matters.

First, applicant has filed a motion to strike certain arguments in opposer's brief on the case. Applicant maintains that these arguments relate to issues which have been raised for the first time in opposer's brief. In particular, applicant seeks to strike arguments relating to the dilution of opposer's marks and a purported deficiency in the specimen submitted with applicant's application.⁸ It

⁸ Opposer maintains that the specimen is a brochure "that Applicant cannot attest was even used in interstate commerce or

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is applicant's position that neither of these issues should be interjected into this proceeding at this late date.

Opposer, on the other hand, citing *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1385-6 (TTAB 1991), argues that once it established its standing in this proceeding, it was entitled to assert any argument in its trial brief, constrained only by the bounds of Rule 11 of the Federal Rules of Civil Procedure (FRCP).

While it is true that an opposer who has properly pleaded its standing in an opposition is entitled to plead any available ground for opposition, the opposer may not assert the ground for the first time in its brief on the case. Where, as here, a claim of dilution was not pleaded in the notice of opposition, such a claim cannot be relied upon by opposer unless the notice of opposition was amended (or deemed amended), pursuant to FRCP 15(a) or (b), to assert the claim. See TMPB Sections 321 and 507.01. In this case, the notice of opposition was not amended to plead dilution and we do not deem the notice of opposition amended to assert the matter. Opposer presented no particular evidence during the trial of this

actually affixed to [applicant's] product." (Opposer's brief, p. 21, footnote 3).

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case that would have put applicant on notice that opposer was asserting a claim of dilution.⁹

⁹ We should point out that opposer's reliance on *Estate of Biro* is misplaced. That case dealt with the issue of whether the plaintiff therein had properly pleaded its standing; not whether the plaintiff could plead additional grounds for opposition.

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With respect to opposer's contention in its brief that the specimens submitted with applicant's application are "deficient," we should point out that a claim that specimens were not used on or in connection with the goods is not a ground for opposition and, therefore, not a matter which the Board would entertain. In this regard, a proper ground for opposition would be that applicant did not use the mark on or in connection with its goods prior to the filing date of the application. However, before the Board could consider such a ground, the notice of opposition would have had to be amended (or deemed amended) to assert the matter. Obviously, in this case, the notice of opposition was not amended to plead this ground and the notice of opposition is not deemed amended to assert such a ground.

In view of the foregoing, applicant's motion to strike is granted to the extent that, in deciding this opposition, we will give no consideration to the arguments in opposer's brief relating to the issues of dilution and the purported deficiency in the specimen submitted with applicant's application. Thus, the only issue before us is that of likelihood of confusion, there being no issue as to

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priority in view of opposer's ownership of valid and subsisting registrations.

An additional matter that requires comment concerns opposer's statement in its brief on the case that it is a holding company, which "owns each of the registrations at issue in the present action and licenses these marks to Pinkerton's Inc." (Brief, p. 9). Applicant, in its brief on the case, characterizes this statement as an "admission against interest." Applicant argues that there is no evidence of record which shows that the use of the marks by Pinkerton's Inc. inures to the benefit of opposer and that this raises a question as to whether opposer is entitled to rely upon use of the marks by Pinkerton's Inc.

Opposer has submitted, by means of notice of reliance, copies of its pleaded registrations. Each of the registrations shows ownership in opposer. Thus, there is no question that opposer is entitled to rely upon the registrations in this proceeding. As noted by the Board in *Liberty & Co. Ltd. v. Liberty Trouser Co., Inc.*, 216 USPQ 65, 66-67 (TTAB 1982) (citations omitted), ownership of a subsisting registration constitutes prima facie evidence of the use of the mark shown therein for the goods or services recited in the registration since

the filing date of the application which matured into the registration. Moreover, there is nothing in this record to indicate that Pinkerton Inc.'s use of the marks does not inure to opposer.

Objections to Testimony and the Record

Applicant has raised objections to certain aspects of the testimony of opposer's witness, Jane Adler. Ms. Adler is an archivist who once worked for opposer and much of her testimony is devoted to recounting the history of opposer and the life of its founder, Allan Pinkerton. Applicant has essentially objected to this testimony on the ground that Ms. Adler does not have personal knowledge of the events to which she has testified.

Obviously, Ms. Adler does not have personal knowledge of events which are alleged to have occurred during Allan Pinkerton's life (1819-1884) and opposer's early beginnings. Also, we recognize that much of Ms. Adler's testimony was based on information derived from the videotapes, books and publications introduced as exhibits during her testimony.¹⁰

¹⁰ The exhibits introduced during Ms. Adler's testimony consist of the following: excerpts from the book titled The Pinkertons: The Detective Dynasty That Made History, James D. Horan (1967); excerpts from the book The Eye That Never Sleeps, Frank Morn (1982); a publication titled History and Evidence of Passage of

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While in certain instances it is somewhat difficult to discern whether certain of the events Ms. Adler testified about are factual or are more akin to legend, we are nonetheless inclined to allow all of Ms. Adler's testimony and accord it appropriate probative value.

Applicant has also objected to the testimony of opposer's witness Alex Felipe concerning the number of contracts opposer has with health care providers. Mr. Felipe testified that during the course of his job as opposer's direct marketing information supervisor, he reviews opposer's database of information concerning opposer's active and inactive clients. According to Mr. Felipe, he obtained the information regarding the contracts with health care providers from opposer's database. Applicant has objected to the testimony on the ground of hearsay, arguing that there is no indication that Mr. Felipe is responsible for the entry of information in opposer's database or that the database is kept in the regular course of business.

Abraham Lincoln from Harrisburg, Pa. To Washington D.C. on the 22nd and 23rd of February 1861 authored by Allan Pinkerton in 1868 and published by the Pinkerton National Detective Agency in 1906; a videotape titled "Inside the Pinkertons" broadcast on the Discovery Channel network in 2000; a videotape titled "Allan Pinkerton The Original Private-Eye" broadcast on the A&E network in 1996; *Detective Agency's Papers Open Window on American Social History*, The Gazette (Library of Congress, Washington

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It is opposer's position, however, that its database is "business information" and, thus, falls into the business records exception to the hearsay rule.

In this case, we are inclined to agree with opposer that a database containing information about client contracts is a business record and, as such, falls within the business records exception to the hearsay rule. Thus, applicant's objections to Mr. Felipe's testimony are not well taken.

Finally, opposer has objected to certain aspects of the testimony of applicant's witness, Kathleen Dowding and applicant's Exhibit 5 thereto. Ms. Dowding is a legal assistant in the office of applicant's counsel. According to Ms. Dowding, she conducted a search of the U.S. Patent and Trademark Office's TESS database for "trademark applications and registrations which had an eye design" and "[t]he search provided 2,871 records of applications and registrations, which contained the eye design." (Dep. 11, 12). Applicant's Exhibit 5 is a list of these marks with the serial and/or registration numbers. Opposer objected to the testimony and the exhibit as hearsay during the deposition and renewed the objections in its brief. In addition, opposer argues

D.C.) June 30, 2000; and a printout of information about Allan

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that the submission of a mere list of third-party applications/registrations is not the proper way to make such applications/registrations of record.

Applicant has not responded to the objections in its brief. Moreover, opposer is correct that the submission of a mere list of third-party applications/registrations is not the proper way to make such applications/registrations of record. Rather, actual copies of the applications/registrations or the equivalent thereof, i.e., printouts of the applications/registrations which have been taken from the USPTO's own computerized database, must be submitted. In the absence thereof, the testimony and the list of applications/registrations is of no probative value.

The record therefore consists of the pleadings; the file of the opposed application; and the trial testimony, with accompanying exhibits of opposer's witnesses Patricia Carlson, Dr. John Brasch (as an adverse witness), Jane Adler, and Alex Felipe. In addition, opposer submitted notices of reliance on, inter alia, status and title copies of its pleaded registrations; printed publications and excerpts from printed publications; a copy of opposer's 1997 annual report;

Pinkerton downloaded from the Biography Online Database.

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copies of promotional brochures; printouts of information downloaded from opposer's website¹¹; and applicant's responses to opposer's interrogatories.

Applicant submitted the trial testimony with related exhibits of its witnesses Dr. John Brasch, Thomas Benes, and Kathleen Dowding. Applicant submitted under notice of

¹¹ While materials such as an annual report, promotional brochure and a printout retrieved from the Internet do not qualify as printed publications under Rule 2.122(e) and generally may not be introduced in an opposition by means of a notice of reliance, in this case, applicant has not objected to these materials on the basis that they were improperly submitted. Thus, we consider applicant to have stipulated to the entry of the annual report, promotional brochures and printouts into the record. *Cf.* *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1834 n.4 (TTAB 1995); and *JSB International, Inc. v. Auto Sound North, Inc.*, 215 USPQ 60 n.3 (TTAB 1982). Indeed, at page 10 of its brief, applicant states that such materials "may come into evidence."

reliance, inter alia, opposer's responses to applicant's interrogatories; copies of third-party registrations for marks which include an eye design; a certificate of incorporation for Pinkerton Systems Integration, Inc.; a dictionary entry for the word "security"; and a status and title copy of its registration for the mark WANDERGUARD and design.

The case has been fully briefed and an oral hearing was held.¹²

The Parties

Opposer

The record shows that opposer is the largest security firm in the United States with over 393 branch offices throughout the country. Opposer offers a wide range of security services, including guard services, pre-employment and employee screening; crisis management, threat assessment, and security systems integration. Opposer's security systems integration services involve selection and deployment of a combination of hardware and

¹² We note that opposer's reply brief is twenty-eight pages in length, including the table of contents and index of cases. Trademark Rule 2.128(b) provides, in pertinent part, that a reply brief shall not exceed twenty-five pages in its entirety. Inasmuch as opposer's reply brief exceeds the page limit set by Rule 2.128(b), it is hereby stricken and has been given no consideration. See *United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (TTAB 1994). Under the circumstances, opposer's

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software technology to provide security to opposer's clients. Such hardware may include access control devices, closed circuit television cameras, optical turnstiles, intrusion detection, electronic imaging, custom security consoles, remote monitoring, video image enhancement, and badging supplies.

Opposer provides its services to a wide range of customers including Toyota and General Motors and other Fortune 1000 companies, the Oscar and Emmy awards, and health care providers.

Opposer's archivist, Ms. Adler, traced opposer's beginnings to the mid-1800's and its founder Allan Pinkerton. Pinkerton immigrated from Scotland to the United States in 1842. In 1850 at the age of 31, Pinkerton founded the Pinkerton National Detective Agency in Chicago, Illinois. It was the first detective agency in the United States and it focused on providing security for people and property. Pinkerton and his agents had an advantage over local police departments in that they could cross city, county and state lines to pursue and capture criminals. They quickly developed a reputation for honesty and integrity. The agency used the depiction

motion to extend the time in which to file a reply brief is

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of a human eye and the motto "We Never Sleep" as its trademark, and a sign bearing this mark hung over the agency's entrance. The agency came to be known as "The Eye That Never Sleeps" or simply "The Eye."

The agency prospered, receiving contracts to provide security services to six major railroads. The railroads had been losing substantial sums of money to conductor embezzlement and Allan Pinkerton established an undercover operation using "spotters" to spot and capture embezzlers. Pinkerton came to know two influential men during this time, George McClellan and Abraham Lincoln. According to a book authored by Pinkerton, his agents learned of a plot to assassinate then President-elect Lincoln during his trip from Pennsylvania to Washington D.C. on the eve of his inauguration. Pinkerton devised a plan whereby he disguised Lincoln and changed his travel arrangements, thereby assuring Lincoln's safe arrival for his inauguration.

During the Civil War, Pinkerton and his agents gathered intelligence for the Union army and General McClellan and they were dubbed the "Secret Service". They were the precursor to the present day government protective agency which bears this name.

denied as moot.

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In the post Civil War era, Pinkerton and his agents were best known for pursuing train robbers and other outlaws. After Pinkerton's death in 1884, his sons William and Robert took over operation of the agency. Following their deaths, the agency was operated by two of Pinkerton's grandsons. Around the time of World War I, the agency began to move away from police work and expand its role in the protection of factory plants and premises. In 1982, the agency was purchased by American Brands who in turn sold it in 1988 to California Plant Protection, Inc. Securitas, a Swedish security firm, recently acquired the agency.

Applicant

Senior Technologies, Inc., is a manufacturer and seller of products to the long-term health care industry. Applicant's products are designed to inform the staff of long-term health care facilities, such as nursing homes, of certain circumstances that may indicate a danger to the patients. Generally, applicant's products are intended for the safety of wanderers, such as Alzheimer patients. Applicant has four product lines - the Arial line for a nurse calling system, the Wanderguard line that indicates unauthorized departure of a patient, the Micro-Tech line that detects motion of a patient, such as

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a wheelchair or a bed, and the Tabs product line that alerts the staff if a patient falls or moves into a dangerous position.

Applicant's involved mark CATCH-ALL and design is used on door alarms for health care facilities, to prohibit unauthorized exit or entry. This product is for infrequently used doors, such as fire doors, and is intended to sound an alarm if a patient (or anyone else) passes through the door. Applicant's CATCH-ALL product is a companion to its Wanderguard product, which is for frequently used doors. Applicant first used the CATCH-ALL and design mark in 1989. According to the testimony of its president, it was applicant's intent in selecting the CATCH-ALL and design mark to choose a mark with an eye design similar to that already in use as part of its WANDERGUARD and design mark since they were to be companion products. Applicant's sales have totaled \$400,000 to \$500,000 since the introduction of its CATCH-ALL and design door alarms.

Priority

As indicated above, opposer made of record status and title copies of its pleaded registrations. Thus, there is no issue with respect to opposer's priority of its registered marks. King Candy Co., Inc. v. Eunice

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King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

We turn our attention to the issue of likelihood of confusion. Our determination under Section 2(d) of the Trademark Act is based on analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. DuPont de

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Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The relevant factors for which there is probative evidence of record are discussed below.

Relatedness or Lack Thereof Between the Goods/Services

We turn first to a consideration of the relatedness or lack thereof between opposer's services and applicant's goods. At the outset, we note that the surveillance services identified in opposer's pleaded registrations are the most relevant of opposer's services in this case. Opposer maintains that its surveillance services and applicant's door alarms for health care facilities are related. Applicant, on the other hand, maintains that these goods and services are specifically different in nature, and thus are not related.

As noted by our primary reviewing court in *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987), "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in opposer's registration, rather than what the evidence shows the goods and/or services to be."

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Further, in the absence of specific limitations in an application or registration, the goods and/or services identified therein must be considered to travel in all "the normal and usual channels of trade and methods of distribution" to all the normal and usual purchasers of the goods and/or services. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983).

Moreover, in order to support a finding of likelihood of confusion, it is not necessary for the goods or services of the parties to be similar or competitive, or even that they move in the same channels of trade. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In *re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1987).

In this case, opposer's surveillance services, including the protection of people and property, are broad enough to include the installation, monitoring, and

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maintenance of door alarms for all types of facilities, including health care facilities. In fact, opposer's witness, Mr. Felipe, testified that opposer offers access control services that include devices such as close-captioned televisions and alarms. Although there are specific differences between opposer's surveillance services and applicant's door alarms for health care facilities, they are nonetheless complementary goods and services, and we find that they are sufficiently related if offered under the identical or substantially similar marks, confusion as to source or sponsorship would be likely. With respect to the other of opposer's services identified in its registrations, namely, private detective services; security guard services; service and repair of automated teller machine services; investigation services; and risk assessment services, we are not persuaded on this record that they are related to applicant's door alarms for health care facilities. In view of the foregoing, this *du Pont* factor favors opposer in regards to its surveillance services.

Channels of Trade/Purchasers

Although applicant's identification of goods contains a restriction such that applicant's door alarms are sold only to "health care facilities," opposer's

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registrations contain no restriction as to channels of trade or purchasers. Thus, we must presume that opposer's surveillance services would move in all the normal channels of trade and be offered to all the usual purchasers, including health care facilities. Thus, for purposes of our analysis, the parties' trade channels and purchasers are identical. Thus, we find that this *du Pont* factor favors opposer.

Degree of Care Exercised by Purchasers of the Goods/Services

The next factor in this case concerns the degree of care exercised by the purchasers of opposer's services and applicant's goods. Clearly, purchasers and prospective purchasers of surveillance services would exercise care in their selection. Such services involve the protection of persons and property and there is no question that a great deal of attention would be paid to selecting a company to provide these services. Also, we would expect purchasers and prospective purchasers of door alarms for health care facilities to exercise care in the selection of these products. Health care facilities have a responsibility to provide a safe and secure environment for their residents. Not only must they comply with government regulations, but they have

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liability concerns as well. Thus, there is simply no question that health care facilities would exercise care in the selection of door alarms that would alert staff to an unauthorized entry or exit. Accordingly, we find that this *du Pont* factor favors applicant. With respect to this factor, our primary reviewing court in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392, stated:

Where the purchasers are the same, their sophistication is important and often dispositive because "[s]ophisticated consumers may be

expected to exercise greater care."
(Citing *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 489, 212 USPQ 246, 252 (1st Cir. 1981).

Fame of Opposer's Marks

The next *du Pont* factor we consider is the asserted fame of what opposer characterizes as the "all seeing eye of Pinkerton." Opposer maintains that its "historic [eye design] form" and "modern [eye design] form", as shown below, are famous. [Opposer's brief, p. 11].

Historic Form¹³

¹³ This design does not reproduce adequately. Surrounding the human eye design in large print are the words "PINKERTON NATIONAL DETECTIVE AGENCY." Directly below the design in small print is the slogan "We never sleep." On the left are the names of the Pinkerton detectives, including of course, Allan Pinkerton.



Modern Form



Fame, of course, is a significant factor in the determination of likelihood of confusion, and can play a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys, Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

There is no dispute that the Pinkerton name is famous. Indeed, applicant's president has acknowledged, "Pinkerton is a well-established brand name." (Brasch dep., p. 43, line 21). Nonetheless, there is insufficient evidence in this record from which we may conclude that either the historic or modern form of the all-seeing eye is famous for opposer's services.

With respect to the historic form of the all-seeing eye, the evidence of record establishes use of this design by Allan Pinkerton and the Pinkerton National Detective Agency in connection with detective services in the late 19th and early 20th century. It is not clear from the record, however, the extent to which this design has

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been used in connection with the surveillance services identified in opposer's registrations since that time. In other words, this record shows the historical significance of opposer's historic all-seeing eye design, but not current use of this design as a mark. While there is no question that the design is referred to in the books/publications of record and in the two television documentaries, this does not establish that the design is so well known among purchasers and prospective purchasers of opposer's services that the design may be said to be famous. So as to be clear, the fact that historians who are knowledgeable about Allan Pinkerton are well aware of the design does not mean that the design is famous in a trademark sense among relevant purchasers.

Further, with respect to the modern form of the all-seeing eye design, there is no testimony or other evidence concerning the length of time opposer has used this design either alone or as part of opposer's composite marks. Moreover, there is no testimony or other evidence concerning the extent of opposer's advertising or promotion of any of its services under this design either alone or as part of opposer's composite marks. Although opposer has made of record

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copies of promotional brochures and an issue of its Solutions magazine wherein the design appears, there is no testimony concerning the extent of distribution of these materials. We recognize that opposer is the leading security firm in the United States, and that it has estimated its goodwill at \$86.4 million. However, this is not enough for us to conclude, as opposer urges, that its modern form of the all-seeing eye design is famous, as opposed to the Pinkerton name. Compare e.g., Bose Corporation v. QSC Audio Products, Inc., No. 01-1216, ___ F.3d ___, ___USPQ2d ___ (Fed. Cir., June 14, 2002); (The marks ACOUSTIC WAVE and WAVE held famous in view of 17 years use of the ACOUSTIC WAVE mark on table-top loudspeaker music system and \$5 million annually in advertising; 8 years use of the WAVE mark on table-top radio with total advertising expenditures of over \$60 million; "vast evidence of public notice given to the marked products"; and "considerable record evidence of advertising and sales literature that also decouples the product marks from the famous [BOSE] house mark"); and Toro Co. v. ToroHead Inc., 61 USPQ2d 1164 (TTAB 2001) [The mark TORO held famous in view of "testimony that [opposer] has over \$1.3 billion in annual sales, that it spends \$35 to \$40 million annually on advertising, and

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that it advertises in trade journals, daily newspapers, national publications, and on national television."]

In sum, opposer has not established on this record that either the "historic" or "modern" form of its all-seeing eye design is famous. Thus, neither its mark which consists of the modern design or its composite marks which include versions of these designs, are in our eyes, famous marks. Accordingly, this *du Pont* factor is neutral.

Third-party Use and/or Registration of Similar Marks

Applicant maintains that marks which include an eye design are weak marks and thus not entitled to a broad scope of protection. In support of its position, applicant submitted sixty third-party registrations for marks that include an eye design for various goods and services. We note that fifty of these registrations cover goods or services not of a type involved in this case or even arguably related thereto. However, ten of the registrations do cover goods and/or services of a type involved in this case or at the very least related to the security field.¹⁴

¹⁴ For example, Registration No. 949,649 is for the mark GUARDWARE and the design of a house and an eye for security hardware, burglar alarms and fire alarms; Registration No. 1,244,789 is for the mark SENTRY SECURITY SYSTEMS, INC. and the design of a pair of eyes for the installation of business and

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Although third-party registrations are not evidence of use of the involved marks or the extent to which the relevant purchasing public is aware of them, as the Board noted in *American Hospital Supply Corp. v. Air Products and Chemicals, Inc.*, 194 USPQ 340, at 343, they are "competent

to establish that a portion common to the marks involved in a proceeding has a normally understood and well-known meaning; that this has been recognized by the Patent and Trademark Office by registering marks containing such a common feature for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a whole; and that therefore the inclusion of [the common element] in each [involved] mark may be an insufficient basis upon which to predicate a holding of likelihood of confusing similarity."

In this case, we find that the pertinent ten third-party registrations are probative of the fact that eye designs have appealed to others in the security field;

home security alarm systems, providing security guard security services, and private investigations and lie detection testing; Registration No. 1,566,744 is for the mark ARGUS SECURITY GROUP, INC. and the design of an eye for security guard services; and Registration No. 1,753,158 is for the mark SMART BOX and the design of an eye for security and key controlled monitoring systems for new car dealerships.

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that such designs are not particularly distinctive in the field; and that an eye design has a readily understood meaning in the field making the inclusion of such a design, per se, an insufficient basis on which to predicate a likelihood of confusion. See *Bost Bakery, Incorporated v. Roland Industries, Inc.*, 216 USPQ 799 (TTAB 1982) and cases cited therein. Accordingly, this *du Pont* factor favors applicant.

Similarity/Dissimilarity of the Marks

Finally, we turn to a determination of what we find to be the key likelihood of confusion factor in this case, namely, whether applicant's mark and opposer's marks, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impression.

In comparing the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods/services offered under the respective marks is likely to result. Furthermore, although the marks at issue must be considered in their entirety, it is well settled that one feature of a mark may be more

significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We consider first opposer's mark WE NEVER SLEEP and the design of a human eye shown below,



and applicant's mark CATCH-ALL and the stylized eye design shown below.



The words WE NEVER SLEEP are the dominant element of opposer's mark and the term CATCH-ALL is the dominant element of applicant's mark. It is appropriate to give greater weight to the word portions of the marks, because

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it by the words that purchasers will refer to opposer's services and applicant's goods, rather than the respective eye designs. In terms of sound, there are obvious differences between WE NEVER SLEEP and CATCH-ALL, and the marks vary greatly in appearance, not only because they include very different words, but also because opposer's realistic depiction of a human eye has a different look from applicant's stylized eye design. In terms of connotation, opposer's mark, as used in connection with its services, suggests a security company with an always watchful eye over persons and property, whereas applicant's mark, as used in connection with its product, suggests an alarm, which will "catch all" persons entering or exiting a door without authorization. We find, therefore, that these marks are dissimilar in their overall commercial impression.

Comparing next opposer's mark PINKERTON and the stylized eye design shown below,



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and applicant's mark, for the same reasons as discussed above we find that PINKERTON is the dominant element of opposer's mark and CATCH-ALL is the dominant element of applicant's mark. Similarly, in terms of sound, appearance and meaning, there are obvious differences between PINKERTON and CATCH-ALL. Further, even a comparison between the stylized eye designs in applicant's and opposer's marks reveals certain differences. In applicant's mark, the stylized eye design forms part of the beginning letter "C" in the term CATCH-ALL. It is a profile type of design and more open in nature, whereas in opposer's mark, the stylized eye design looks somewhat like the letter "P," is a more frontal type of design and is more closed.

In terms of connotation, as noted above, applicant's mark suggests an alarm which will "catch all" persons entering or exiting a door without authorization. Opposer's mark, on the other hand, suggests that the Pinkerton Company is keeping a watchful eye over persons and property. We conclude therefore that these marks also have dissimilar overall commercial impressions.

Turning next to opposer's mark, which consists of the stylized eye design alone shown below,



and applicant's mark, in view of the differences noted above between the stylized eye designs in these respective marks, and more importantly because of the inclusion in applicant's mark of the term CATCH-ALL, we find that the overall commercial impressions of these marks are likewise dissimilar.

Turning finally to opposer's mark PINKERTON and the stylized eye design shown below,



and applicant's mark, again we find that PINKERTON is the dominant element of opposer's mark and the term CATCH-ALL is the dominant element of applicant's mark. And, in

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terms of sound, appearance and meaning, there are obvious differences between PINKERTON and CATCH-ALL. In terms of the respective stylized eye designs, opposer's design appears above PINKERTON and is more open in appearance whereas applicant's design forms part of the beginning letter "C" in the term CATCH-ALL. These marks have different connotations as discussed above, and we conclude that they likewise have dissimilar commercial impressions.

In sum, when we compare applicant's mark and each of opposer's marks in their entireties as to appearance, sound and meaning, we find that they are dissimilar in terms of their overall commercial impressions. In view thereof, we conclude that this *du Pont* factor weighs in favor of applicant.

In summary, after careful consideration of the evidence of record with respect to the relevant *du Pont* factors and the parties' arguments with respect thereto, we conclude that there is no likelihood of confusion in this case. That is, notwithstanding the fact that opposer's surveillance services and applicant's door alarms for health care facilities are related and may be marketed to the same purchasers, we find that opposer's marks and applicant's mark are too dissimilar to support

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a determination that confusion is likely. Moreover, we find that the design of an eye, which is the only feature the marks have in common, is routinely adopted in the security field, and thus not a feature of opposer's marks which is entitled to a broad scope of protection.

Additionally, we find that the respective purchasers of opposer's surveillance services and applicant's door alarms for health care facilities would be discriminating, thus making confusion unlikely.

Decision: The opposition is dismissed.

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